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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,540	10/30/2001	Gusui Wu	0173.210US	9183
27310	7590	03/01/2005	EXAMINER	
PIONEER HI-BRED INTERNATIONAL INC. 7100 N.W. 62ND AVENUE P.O. BOX 1000 JOHNSTON, IA 50131			HELMER, GEORGIA L	
		ART UNIT	PAPER NUMBER	
			1638	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/020,540	WU ET AL.
	Examiner Georgia L. Helmer	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 November 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Status of the Claims***

1. The Office acknowledges the timely receipt of Applicant's Response dated 22 November 2004, and of Appendix A. Claims 1-8, 20 and 28 are amended. Claims 1-30 are pending and are examined with respect to SEQ ID NO: 1 in the instant action.
2. This action is made FINAL necessitated by Applicant's amendment.
3. All rejections not addressed below have been withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112-first***

5. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The phrase "less than 1000 base pairs in length" is not supported by the originally filed specification or claims. Applicant is invited to point out the page and line number in the specification where support for this phrase can be found. Absent such support, Applicant is required to cancel the new matter in response to this Office Action.

6. Claims 1-4 and 6-30 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Applicants present a complete promoter sequence as set forth in SEQ ID NO:1 (specification, p. 36, lines 13-15), which is sequences 6816-7291 of the SVBV –E3 genome. Applicants do not describe any polynucleotide promoter sequences that are 90%, 80% or 70% identical to SEQ ID NO: 1. Applicant further do not describe any polynucleotide promoter sequences that are at least 90% identical to 100 contiguous nucleotides in a nucleotide sequence of SEQ ID NO: 1, or to the promoter comprising at least 20 contiguous nucleotides in the nucleotide sequence of SEQ ID NO: 1, and to the promoter comprising at least 40 contiguous nucleotides in a nucleotide sequence of SEQ ID NO: 1.

Applicant traverses saying primarily (Response, p. 6) that they present four nucleotide sequences in this application, of which SEQ ID NO: 1 is currently under examination. Applicant says further that even though the three other SEQ ID NOs are not under examination in the instant case, these are other promoter sequences in the instant case (Response, p. 7). Applicant says further that they provide SEQ ID NO: 1 as the SVBV promoter initially isolated from the SVBV E3 genome, that SEQ ID NO: 2 is a modification of SEQ ID NO: 1, providing a minimal SVBV promoter, that SEQ ID NO: 3 is a modification of SEQ ID NO: 2 , as is SEQ ID NO: 4.

Applicant's traversal is unpersuasive. The genus described in the claimed invention, that of promoters isolated from the SVBV E3 genome, all derived from the

single genomic clone of SVBV E3, is much narrower than 80% identity to SEQ ID NO: 1 over the entire length. Applicant's claims do not recite the SVBV E3 gene and the presence of particular consensus sequence(s)/ minimal promoter elements.

***Claim Rejections - 35 USC § 112-Enablement***

7. Claims 1-4 and 6-30 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid comprising a promoter comprising SEQ ID NO: 1, does not reasonably provide enablement for the broad scope of the claim, for reasons of record in the Office Action of 31 August 2004.

***Claim Rejections - 35 USC § 102***

8. The rejection of claims 1-15, 21-25, and 27-30, rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/96584 (priority filing 12 June 2000, US 60/210,917, designating the US), is withdrawn in response to Applicant's amendment of the claims to recite "a promoter of less than 1000 bp in length".

***Claim Rejections - 35 USC § 103***

9. The rejection of claims 1-15, and 21-30 under 35 U.S.C. 103(a) as being unpatentable over WO 01/96584 (priority filing 12 June 2000, US 60/210,917,

designating the US) as discussed above in the 102(e) rejection for claims 1-15, 21-25, and 27-30, in view of Hiei et. al., (US 5,591,616 issued 7 January 1997), is withdrawn in response to Applicant's amendment of the claims to recite "a promoter of less than 1000 bp in length".

***Remarks***

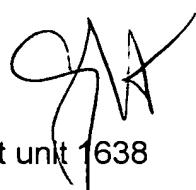
10. Claims 1-30 are not allowed, given the 112.1 rejections.
11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia Helmer PhD  
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1 February 2005



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